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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,027	01/24/2002	Friedrich Jonas	Mo6935/LeA 34,765	3582
23416 7590 06/22/2010 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
METZMAIER, DANIEL S				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/22/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/057,027

Applicant(s)

JONAS ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claims 1, 4-5 and 9 are pending.

Response to Amendment

Applicants' response filed on 24 March 2010 has not complied with the 37 CFR 1.57.

The following objections and rejections remain. See Decision by the Board of Appeals, Appeal No. 2009-000622, Application 10/057,027, page 6, mailed 22 September 2009¹. See also 37 C.F.R. §§ 1.57. See MPEP § 608.01(p), I. Incorporation By Reference, 2, Improper Incorporation (8th ed., Rev. 5, August 2006).

" . . . Any underlying objection or rejection (e.g., under 35 U.S.C. 112) should be made by the examiner until applicant corrects the improper incorporation by reference by submitting an amendment to amend the specification or drawings to include the material incorporated by reference. A statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter is also required. 37 CFR 1.57(f). . . . "

Claim Rejections - 35 USC § 112

1. The following rejection is made in the alternative to the rejections base on the prior art rejections, which follow.
2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 1, 4-5, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants improperly incorporate subject matter that was not present in the originally filed disclosure by amendment regarding making the claimed composition.

The amendment filed 19 November 2009 to the specification is an attempt to correct an "improper incorporation by reference". Please see the present amendment and the summarization thereof above.

The reference to EP A-991 303 is made throughout applicants' specification regarding the making of applicants' invention². It has been the Office position that the reference to EP A-991 303, specified in example 2, **constitutes essential subject matter** and this **has been uncontested** by applicants³.

The Board Of Appeals states⁴ regarding the improper incorporation of essential subject matter: "... Appellants' recourse is to correct the matter as provided in 37 C.F.R. §§ 1.57(g). See MPEP § 608.01(p), I. Incorporation By Reference, 2, Improper Incorporation (8th ed., Rev. 5, August 2006)."

¹ Hereafter Decision, Appeal No. 2009-000622.

² Please see Decision, Appeal No. 2009-000622, pages 3 and 4, "Findings of Fact".

³ Please see Decision, Appeal No. 2009-000622, page 4, "Opinion".

⁴ Please see Decision, Appeal No. 2009-000622, page 6.

Applicants have not complied with the Rule or the MPEP⁵ and the rejection is maintained in accordance with the MPEP as denoted above.

Rule 37 C.F.R. §§ 1.57 was set forth in the Office Action mailed 24 December 2010 and is not repeated here for brevity.

More specifically, the initial or original specification having an improper incorporation by reference was deficient regarding 37 C.F.R. §§ 1.57(b)(1) and 37 C.F.R. §§ 1.57(c). Applicants attempt to correct 37 C.F.R. §§ 1.57(c) but have not yet complied with 37 C.F.R. §§ 1.57 and MPEP § 608.01(p), I. Incorporation By Reference, 2, Improper Incorporation (8th ed., Rev. 5, August 2006).

An amendment that would be deemed to comply would include:

- (1) express their clear intent as specified in 37 C.F.R. §§ 1.57(b)(1),
- (2) a copy, such as a certified translation, of the subject matter of EP A-991 303 to be incorporated to comply with 37 C.F.R. §§ 1.57(e),
- (3) a statement in accordance with 37 C.F.R. §§ 1.57(f).

It is noted that the amendment does not **"incorporate by reference"** the subject matter in the translation or the subject matter referenced in the original specification, *i.e.*, example 2 of EP-A-991 303. The amendment adds a reference to US Patent 6,391,481.

The amendment does not correct the improper incorporation by reference of essential subject matter but make an additional reference to subject matter alleged to be incorporated. Said amendment fails to meet 37 CFR 1.57(b)(1).

⁵ See MPEP § 608.01(p), I. Incorporation By Reference, 2, Improper Incorporation (8th ed., Rev. 5,

Response to Arguments

4. Applicant's arguments filed 24 March 2010 have been fully considered but they are not persuasive. Said arguments have been addressed in the above rejection under 35 USC 112, 1st paragraph.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Daniel S. Metzmaier/
Primary Examiner, Art Unit 1796**

DSM